from October 5, 2000, to January 5, 2001. Please charge the three month extension fee of $890.00 to our account no. 10-0100.

The Examiner has objected to claims 23, 34, and 36 because of a common informality. All of these claims have been amended to overcome this objection. The Examiner's care in pointing out the objection is appreciated.

Claims 23-28 have been rejected as being obvious on the basis of Murata et al. '743, in view of Lowe et al '401, Best '073, Best '152 *and* Cookson et al '950., for reasons set forth in paragraph 2 of the Office Action. In paragraph 4 of the Office Action, the Examiner has remarked why the arguments filed by applicants with the last filed Amendment were not deemed persuasive. In doing so, the Examiner appears to have repeated the rejections, at least in part, but did not address the salient or critical distinction discussed in the last filed Office Action, starting at page 8. Murata was distinguished as not being spontaneous or creative. The difference is almost like comparing random and pre-selected, arbitrary and ordained, or arbitrary and predictable. Thus, as previously explained, one can almost predict what message(s) will get generated by Murata on the basis of the type of play involved. This is particularly true after a player has used the Murata

device and has become familiar with the messages and knows what to expect. This type of predictability does nothing to enhance the interest and excitement of the game. On the other hand, with the present invention the message announced adjusts to the nature of the event. However, the messages are spontaneous and relevant and, yet, unpredictable. The present invention is, therefore, much more realistic and better simulates the nature of the announcements in an actual setting.

The Examiner has formulated the Final Rejection on the basis of obviousness when considering the primary Murata patent in view of or when combined with *four additional* references. However, the Examiner seems to confuse non-predictability resulting from switching an increased number of databases and the ability of the subject invention to automatically provide unpredictability by the inherent nature of the system. Being predictable because of a larger database does not result in unpredictability, as the Examiner suggests. Real unpredictability results from randomness, and not from an ordained selection from a larger pool. Therefore the Best patents add nothing to Murata. The same is true of Cookson, which by the Examiner's own statement may teach the manipulation of databases. For the aforementioned reasons, these references,

separately or in combination, do not teach or suggest the present invention. No one reference, and no combination, suggests the randomly selection of one of a plurality of related, equally appropriate words or phrases. It is respectfully submitted that the secondary references add nothing to Murata, which the Examiner explicitly concedes needs more than its own teachings to render the present invention obvious.

Additionally, applicant respectfully disagrees that it would have been obvious to combine the teachings of Murata with the teachings of the *four* secondary references without the hindsight of the subject application and the teachings contained therein. First, the Examiner has not explained why it would be obvious to a person skilled in the art to combine the references as has been proposed by the Examiner. Second, for the reasons aforementioned, the combination, even if made, would not result in the invention as claimed. There would be no incentive for one skilled in the art to make the combination and, then, to make the additional modifications needed to arrive at the present invention. Nothing in the Examiner's rejection suggests how this could be otherwise. Applicant's traversal, then, is believed to be strongly confirmed by the fact that the

references cited by the Examiner have been selected from several diverse classes and subclasses, many of which are directed to very different arts. One expert in *one* of these arts would not necessarily be expert in the *other* arts. Again, without a clear incentive to combine *five* references, it is almost necessary to conclude that obviousness cannot exist and that any proposal to combine so many references could only be made through a "hindsight reconstruction" – something clearly forbidden by the Court of Appeals for the Federal Circuit and by the Patent Act.

Applicant also respectfully request that the finality of the Office Action be withdrawn. Under MPEP 706.07(b), it is clear that upon the re-filing of a CPA application, a Final Rejection as a first Office Action is only proper when the rejection would have been "properly" finally rejected on the grounds of the art of record. However, for the reasons discussed above, applicants believe that the five references relied upon by the Examiner are an improper combination and could not have been the basis for a rejection in the earlier application, even if drawn to the same invention. In this case, it is noted, applicant submitted a Preliminary Amendment to further define the invention. This Preliminary Amendment further removed the invention from the invention as claimed in the parent application.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the outstanding rejections in the parent application and withdraw the same. It is believed that this continued prosecution application is in condition for allowance. Early allowance and issuance is, accordingly, respectfully solicited.

Dated: December 14, 2000

Respectfully submitted,

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MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Services as Express Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on the date indicated below:

Myron Greenspan
Attorney's Name

_____
Signature

December 14, 2000
Date

Applicant hereby petitions that any and all extensions of time of the term necessary to render this response timely be granted. Costs for such extension(s) and/or any other fee due with this paper that are not fully covered by an enclosed check may be charged to Deposit Account #10-0100.